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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,928	09/15/2003	Bret M. Berry	31132.153	2720
46333	7590	01/19/2006		
HAYNES AND BOONE, LLP 901 MAIN ST SUITE 3100 DALLAS, TX 75202			EXAMINER SNOW, BRUCE EDWARD	
			ART UNIT 3738	PAPER NUMBER

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/662,928	Applicant(s) BERRY ET AL.	
	Examiner Bruce E. Snow	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 19-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I and Species 2 (Figures 4a and 4b) in the reply filed on 11/14/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 19-30 and 33-53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species as indicated by applicant. Additionally, the Examiner withdraws claims 31-32 directed to a non-elected species; clearly the elected species does not comprise a stacking member, first prosthetic insertion device, and a second prosthetic insertion device.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: prosthetic insertion device, receiving means, locking means, vertebral-engaging members. It is applicant's duty to ensure all claim language is supported in the specification with appropriate reference numerals.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 14, 15, 16, what is the "prosthetic insertion device", a tool?

Claim 12, what elements is the "wall extending transversely"?

Claim 14, "the first end member" lacks antecedent basis.

Claim 16, receiving means is not supported nor understood.

As far as the scope of the claims can be determined, the following rejections are made of record.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5, 9-12, 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Allen (5,658,335).

Allen teaches:

1. An anchoring device for disposition within an intervertebral space, comprising first and second end members 90, the first and second end members cooperating to receive a prosthetic insertion device (any other element shown), wherein the first and second end members each comprise a first surface, at least one vertebral-engaging member 98 extending from the first surface, a second surface in an opposed relation to the first surface, and at least one flange 94 extending from the second surface.
2. The anchoring device of claim 1 further comprising at least one cam device 70, the cam device being moveable between a first position and a second position.
3. The anchoring device of claim 2 further comprising an access hole for accessing the cam device, see figure 13.
4. The anchoring device of claim 1 wherein the at least one vertebral-engaging member is angled relative to the first surface.

5. The anchoring device of claim 1 wherein the at least one vertebral-engaging member comprises a sharp edge.

14. Note figure 8 showing the vertebral-engaging members 98 being conical in shape wherein the exterior surfaces are angled towards each other.

Claims 1, 4-13, 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Stimonson (6,572,653).

Stimonson teaches:

1. An anchoring device for disposition within an intervertebral space, comprising first 56 and second 74 end members (see figure 4), the first and second end members cooperating to receive a prosthetic insertion device 48, wherein the first and second end members each comprise a first surface, at least one vertebral-engaging member 62 extending from the first surface, a second surface in an opposed relation to the first surface, and at least one flange 64,82 extending from the second surface.

4. The anchoring device of claim 1 wherein the at least one vertebral-engaging member is angled relative to the first surface.

5. The anchoring device of claim 1 wherein the at least one vertebral-engaging member comprises a sharp edge (sharp enough to penetrate bone).

6. The anchoring device of claim 1 wherein the at least one vertebral-engaging member and the first surface are coated with a bone-growth promoting substance. See 2:37 et seq.

10. See flanges 84, 66.

13. See the hole formed by the bending of elements 62, 78.

14-15. See 4:60 et seq. Describing a locking means.

17. The elongate slot is formed by elements 66, 84.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. 6,176,882 – Note holes 69.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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BRUCE SNOW
PRIMARY EXAMINER